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10/612,542	07/01/2003	Yen-Kuang Chen	42P15766	3544

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
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SUNNYVALE, CA 94085-4040

EXAMINER
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MALZAHN, DAVID H

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2193

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/612,542  
Filing Date: July 01, 2003  
Appellant(s): CHEN ET AL.

**MAILED**

**OCT 12 2007**

**Technology Center 2100**

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Lawrence M. Mennemeier  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11 September 2007 appealing from the Office action mailed 26 March 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 24-29.

Claims 1-23 and 30-39 are allowed.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The outstanding rejection of claims 1-23 and 30-39 under 35 USC 101 has been withdrawn.

**WITHDRAWN REJECTIONS**

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The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The outstanding rejection of claims 1-23 and 30-39 under 35 USC 101 is hereby withdrawn.

Claims 24-29 remain rejected under 35USC 101.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24-29 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble of claim 24 calls for "An article comprising a tangible machine readable medium that stores a program, said program being executable by a machine to perform a method comprising". The preamble is followed by two steps. Paragraphs 0028-0030 of the specification define the "machine readable medium" is including a transmission medium which may be a carrier wave. The word "tangible" does not appear in the specification so going to a dictionary to determine the standard or common meaning results in a definition of "capable of being perceived especially by the sense of touch" according to the On Line Merriam-Webster dictionary for the adjective "tangible". A carrier wave is clearly capable of being perceived. Since the claims read on a transmission medium which may be carrier waves the claims read on

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a form of energy which fails to fall within any of the statutory categories of invention, i.e. the claims are neither process, machine, manufacture or composition of matter.

**(10) Response to Argument**

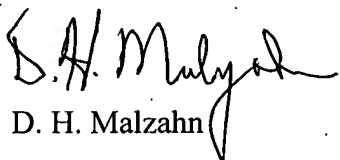
Appellants argue that claims 24-29 are not directed to a program per se and that the claimed invention has a practical application but both arguments are moot because the Examiner in not arguing either program per se or lack of practical application, but lack of statutory category for the claimed invention. Appellants state, last paragraph of page 9 of the Brief, that the instant claims are directed to statutory processes, articles and apparatus but fail to support this conclusionary statement.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

  
D. H. Malzahn

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